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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte R. THOMAS GROTZ

Appeal 2015-000331
Application 12/460,703
Technology Center 3700

Before KEVIN W. CHERRY, CYNTHIA L. MURPHY, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant (R. Thomas Grotz) appeals under 35 U.S.C. § 134 from the Examiner's rejections of claims 1–22, 31, 33, and 35–41. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

The Appellant's invention "relates to arthroplasty, and more particularly, to an implant for use in arthroplasty." (Spec. ¶ 2.)

Illustrative Claim

1. A resilient orthopedic implant comprising:
 - a. a first wall configured to engage an articulating end of the acetabulum of the pelvic bone;
 - b. a second wall configured to engage an articulating end of the femur, the second wall having one or more appendages configured to secure, directly or indirectly, the second wall to the articulating end of the femur;
 - c. a side wall extending between the first wall and the second wall and configured to facilitate relative motion between the first and second walls; and
 - d. an interior portion enclosed by the first, second, and side walls; wherein at least some length of the first wall overlaps at least some length of the second wall creating a concave fold in the implant, the concave fold in the implant comprising of at least some length of the side wall,wherein the implant is configured for deployment between the articulating ends of the femur and the acetabulum of the pelvic bone of the hip joint structure, and wherein neither the femur nor the pelvic bone is resected.

References

Pederson	US 2003/0093152 A1	May 15, 2003
Hunter	US 2005/0182463 A1	Aug. 18, 2005
Hendrik	DE 103 39 605 A1	Apr. 14, 2005

Rejections

- I. The Examiner rejects claims 1, 3–14, 20–22, 31, and 35 under 35 U.S.C. § 102(b) as anticipated by Hendrik. (Final Action 5.)
- II. The Examiner rejects claims 15–19, 33, and 36–41 under 35 U.S.C. § 103(a) as unpatentable over Hendrik and Hunter. (*Id.* at 11.)

III. The Examiner rejects claims 1, 3–14, 20–22, 31, and 35 under 35 U.S.C. § 102(b) as anticipated by Pederson. (*Id.* at 7.)

IV. The Examiner rejects claims 8–13, 31, and 33 under 35 U.S.C. § 112, second paragraph, as indefinite. (*Id.* at 2.)

V. The Examiner rejects claims 12 and 13 under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form. (*Id.* at 4.)

VI. The Examiner provisionally rejects claims 1–22, 31, 33, and 35–41 on the ground of nonstatutory double patenting as being unpatentable over claims 1–36 of US Application 13/574,517 and/or over claims 1–31 of US Application 13/514,539. (*Id.* at 15.)

ANALYSIS

Claim 1 is the sole independent claim on appeal with the rest of the claims on appeal (i.e., claims 2–22, 31, 33, and 35–41) depending therefrom. (Appeal Br., Claims App.) Independent claim 1 is directed to “[a] resilient orthopedic implant.” (*Id.*)

Rejection I—35 U.S.C. § 102 - Hendrik

Independent claim 1 requires “a concave fold in the implant.” (Appeal Br., Claims App.) The Examiner finds that Hendrik discloses an implant having such a concave fold. (See Final Action 5–6, especially annotated drawing on page 6.)

The Appellant argues that Hendrik’s implant has a “convex fold,” not a “concave fold” as required by independent claim 1. (Appeal Br. 7.) In this regard, the Appellant provides definitions, drawings, and detailed discussions regarding concavity, convexity, isolated curves, and/or optical geometric shapes. (See *id.* 6–7; see also Reply Br. 4–6.)

We are not persuaded by these arguments because they are not commensurate with the claim language. Independent claim 1 does not recite a point of reference for identification of features of the fold (*see* Answer 4) in contrast to, for example, original claims 12 and 13 which recited that “the first wall has an **exterior surface** with a concave shape” and that “the second wall has an **exterior surface** with a convex shape.” (Spec., 29, emphasis added.) And we agree with the Examiner that the fold in Hendrik’s implant has a concave interior surface, and thus can be considered “a concave fold in the implant.” (Answer 5.)

Thus, we sustain the Examiner’s rejection of independent claim 1 under 35 U.S.C. § 102(b) as anticipated by Hendrik. The Appellant does not argue dependent claims 3–14, 20–22, 31, and 35 separately from independent claim 1 (*see* Appeal Br. 7), and so they fall therewith.

Rejection II – 35 U.S.C. § 103 – Hendrik and Hunter

With respect to the dependent claims rejected as unpatentable over the combined teachings of Hendrik and Hunter, the Appellant argues only that “Hunter does not remedy the deficiency in Hendrik” in failing to disclose the “concave fold” required by independent claim 1. (Appeal Br. 12.) However, as discussed above, we are not persuaded by the Appellant’s position that Hendrik is deficient in this regard.

Thus, we sustain the Examiner’s rejection of dependent claims 15–19, 33, and 36–41 under 35 U.S.C. § 103(a) as unpatentable over Hendrik and Hunter.

Rejection III – 35 U.S.C. § 102 - Pederson

As indicated above, independent claim 1 requires “a concave fold in the implant.” (Appeal Br., Claims App.) The Examiner finds that Pederson

shows, in Figure 10, an implant having such a concave fold. (*See* Final Action 7–9, especially annotated drawing on page 9.)

The Appellant advances arguments similar to those discussed above as to why Pederson discloses a “convex fold” and not a “concave fold.” (*See* Appeal Br. 9–11; *see also* Reply Br. 4–7.) For the same reasons discussed above, we are not persuaded by these arguments. And we agree with the Examiner that the implant shown in Pedersen’s Figure 10 has a concave interior surface and thus can be considered a concave fold in the implant. (*See* Answer 5.)

Thus, we sustain the Examiner’s rejection of independent claim 1 under 35 U.S.C. § 102(b) as anticipated by Pederson. The Appellant does not argue dependent claims 3–14, 20–22, 31, and 35 separately from independent claim 1 (*see* Appeal Br. 11), and so they fall therewith.

Rejections IV and V—35 U.S.C. § 112

The Appellant does not argue the Examiner’s rejections under 35 U.S.C. § 112 on appeal (*see* Reply Br. 3) and thus we summarily sustain the Examiner’s rejections of claims 8–13, 31, and 33 under 35 U.S.C. § 112.

Rejection VI—Double Patenting

The previously copending applications on which this rejection is based have been abandoned¹ and thus we dismiss as moot the Examiner’s provisional rejection of claims 1–22, 31, 33, and 35–41 on non-statutory double patenting grounds.

¹ PTO electronic records indicate that US Application 13/574,517 was abandoned on October 29, 2015 and that US Application 13/514,539 was abandoned on March 19, 2016.

DECISION

We AFFIRM the Examiner's rejections of claims 8–13, 31, and 33 under 35 U.S.C. §§ 102, 103, and 112.

We DISMISS as moot the Examiner's provisional rejection of claims 1–22, 31, 33, and 35–41 on non-statutory double-patenting grounds.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED